

REMARKS

Claims 1-31 are pending. No amendments have been made by way of the present submission, thus, no new matter has been added.

In the outstanding Office Action the Examiner has required Applicants to elect one of the following five groups.

Group I, claims 1-9, drawn to a method for decreasing foam formation during cultivation of a microorganism by modifying the microorganism in a way that the microorganism does not produce hydrophobic protein(s).

Group II, claims 10-12, drawn to a method for producing a product by cultivating a microorganism that is modified in a way that the microorganism does not produce hydrophobic protein(s).

Group III, claims 13-19, drawn to a production host strain that is genetically modified in a way that the microorganism does not produce hydrophobic protein(s).

Group IV, claims 20-30, drawn to a production host strain that is genetically modified in a way that the microorganism does not produce hydrophobic protein(s) and that is modified to produce a product of interest.

Group V, claim 31, drawn to a method for producing a product of interest by cultivating a microorganism that is modified in a way that the microorganism does not produce hydrophobic protein(s) and that is modified to produce a produce of interest.

Applicants respectfully traverse.

The Examiner has asserted that the groups listed above do not relate to a “single general inventive concept” under PCT Rule 13.1 because, pursuant to PCT Rule 13.2, they allegedly lack the same or corresponding “special technical feature”. Applicants respectfully disagree with the Examiner. Any international application must relate to one invention only or to a group of inventions so linked so as to form a single general inventive concept.

As pointed out by the Examiner, unity of the invention exists only when there is a technical relationship among the claimed inventions involving one or more special technical features. The term “special technical features” is defined as meaning those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. In the present instance, the Examiner has asserted that a special technical feature is known in the art. For instance, the Examiner makes reference to a “special technical feature” being known in the prior art by the reference of Nakari-Setälä et al. Eur. J. Biochem 1997, 248; 415-423.

Applicants disagree with the Examiner. Neither Nakari-Setälä et al. Eur. J. Biochem 1997, 248; 415-423 nor Nakari-Setälä et al. Eur. J. Biochem 1996, 235; 248-255, disclose a correlation between hydrophobins such as HFBI and HFBII, and foam formation. The foaming

properties of HFBI and HFBII were not known and a skilled person could not have had a reasonable expectation of success in reducing foaming and improving protein production in a host by reducing the HFBI and/or HFBII concentration “below an essential amount.” The Examiner is referred to page 3, second paragraph (3.4) of the Communication from the European Patent Office (copy enclosed).

Accordingly, Applicants respectfully submit that the “special technical feature”, shared by each of the claims, which relates to a correlation between HFBI and HFBII and foam formation does represent the contribution over the prior art. As such, Applicants submit that the present claims have unity of invention.

The Examiner has further asserted that the claims are drawn to more than one permissible combination of categories of invention, such as more than one product and more than one process of making and/or use of said product. The Examiner asserts that there are at least two products as claimed that are host strains having either one modification or two modifications including modifications in expression of hydrophobins and expression of a product of interest. Although this may generically relate to new products, Applicants point out that the product may be produced naturally by the production host or the host may be modified to produce the desired product. In either instance, the claims require the correlation between hydrophobins (e.g., HFBI and HFBII) and foam formation. Thus, the special technical feature serves to link all of the present claims.

Further, each of the method claims also require preparing a host having decreased foaming in order to produce a protein product. This also relies on the correlation between hydrophobins (e.g., HFBI and HFBII) and foam formation.

Further, Applicants point out that although lack of unity invention should be raised in clear cases, it should neither be raised nor maintained on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with PCT article 33(6), by any additional document considered to be relevant. MPEP §1850 (page 1800-95, revision to May 2004). Accordingly, Applicants traverse the Examiner's unity of invention rejection.

However, in order to be fully responsive to the outstanding Office Action, Applicants hereby elect Group I, claims 1-9. This is an election with traverse.

Favorable action on the merits is respectfully requested.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

- ☒ Attached is a Petition for Extension of Time.
- ☒ Attached hereto is the fee transmittal listing the required fees.


Application No.: 10/050,000

Docket No.: 0365-0529P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

for  #42-874
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Attachment: Communication from EPO